

Appl. No. : 09/630,931
Filed : August 2, 2000

REMARKS

Claims 1-50 are currently pending. No new claims have been added. Claims 1-6 and 21-50 have been withdrawn. Accordingly, elected claims 7-20 are currently presented for examination.

Claims 17 and 20 have been amended to correct minor typographical errors. No new matter has been added by this amendment.

After careful consideration of the Examiner's rejection of the elected claims, Applicant respectfully traverses for the following reasons.

Rejection of Claims Based on 35 U.S.C. § 102(a)

Claims 7-20 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by the disclosure of Kalabat *et al.* (1998) *Biotechniques* 25:1030-1035. In particular, the Examiner asserts that Kalabat *et al.* disclose a method for identifying a regulatory element capable of directing or regulating transcription within a test nucleic acid sequence by linking the test nucleic acid sequence to a polynucleotide sequence encoding a chitobiase polypeptide which lacks a signal peptide, introducing the resulting nucleic acid construct into a cell and determining the level of chitobiase activity. It is further alleged that Kalabat *et al.* disclose every element of each of the claims that depend from Claim 7.

Applicant submits herewith a Declaration under 37 C.F.R. § 1.132 by Dr. Judith Zyskind who is the sole inventor of the subject matter claimed in the subject patent application. The Declaration states that Dr. Zyskind is a co-author of the reference Kalabat *et al.* and that she alone conceived of the subject matter that is first described therein. In accordance with the rule set out in *In re Katz*, 687 F.2d 450 (CCPA 1982), the Declaration of Dr. Zyskind is sufficient to establish that she alone conceived the subject matter first described in Kalabat *et al.*. Accordingly, Kalabat *et al.* is not available as prior art under 35 U.S.C. § 102(a) against the claims of the subject patent application because it is not the work of another.

CONCLUSION

Applicants believe that all outstanding issues in this case have been resolved and that the present claims are in condition for allowance. Nevertheless, if any undeveloped issues remain or

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if any issues require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite the resolution of such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept. 05, 2003

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